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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,521	10/28/2003	Hannu Mahonen	KOLS.054PA	5404

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Hollingsworth & Funk, LLC
Suite 125
8009 34th Avenue South
Minneapolis, MN 55425

EXAMINER

LIM, STEVEN

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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08/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/695,521

Applicant(s)

MAHONEN ET AL.

Examiner

Steven Lim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 16 states a "computer program product", which can be considered a data structure. Claim 17 states a "computer program product", which also can be considered a data structure. Claim 18 states "a data structure".

3. Regarding Claims 16 and 17, a computer program product is neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

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4. Regarding Claim 18, data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-7, and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Littleton et al. (US 20030023759).

8. Regarding Claims 1, 9, 12, 15, 16, 17, and 18, Littleton et al. discloses a synchronization system comprising two synchronization devices (PDA and PC) and where the first synchronization device (PDA) comprises a user data unit (contact

information including phone numbers and addresses, Paragraph 15), defining in the synchronization system through a database, binding data (contact record and service features, Paragraph 15 and 22) which associates a user data identifier (phone number, Paragraph 22) identifying the user data unit with at least one function of the first synchronization device (Paragraph 22), performing a synchronization step between the first synchronization device and the second synchronization device, the step comprising transferring the user data unit and the binding data from the first device to the second device (service features and phone numbers are compressed and sent to PC, Paragraphs 23 and 25), and forming binding between the user data unit and at least one function of the second synchronization device in the second synchronization device in accordance with the binding data (PC accesses records on PDA for use in emailing program Outlook and address book within Palm Desktop, Paragraph 18), however Littleton et al. fails to disclose performing a second synchronization step to transfer the binding data in response to the transfer of the user data.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to synchronize the binding data separately since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichmena*, 168 USPQ 177, 179.

9. Regarding Claim 2, Littleton et al. further discloses checking in the second synchronization device whether the first synchronization device supports binding data synchronization (matching applications, Paragraph 24), and transmitting the binding

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data from the first synchronization device to the second synchronization device in the second synchronization step in response to the fact that the second synchronization device supports binding data synchronization (Paragraph 25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to check in the first synchronization device whether the second device supports binding data synchronization since it has been held that rearranging parts of an invention involved only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

10. Regarding Claim 3, Littleton et al. further discloses the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit (contact record, Paragraph 15) with a resource identifier (phone number, Paragraph 15), which is used by at least one application (address book database application, Paragraph 20).

11. Regarding Claim 4, Littleton et al. further discloses the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit (contact record) with a device data unit (anonymous call reject service feature) which is a data unit affecting the operation of the second synchronization device (Paragraph 20 and 22).

12. Regarding Claim 5, Littleton et al. further discloses the user data unit is a phone number (Paragraph 15) and the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit with a device data unit, which is a speed dial number (speed dial, Paragraph 22).

13. Regarding Claim 6, Littleton et al. further discloses the user data unit is a phone number (Paragraph 15) and the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit with a device data unit, which is the identifier of a caller group (distinctive ring on a group, Paragraph 20).

14. Regarding Claim 7, Littleton et al. further discloses synchronizing the device data unit from the first synchronization unit to the second synchronization unit in connection with the synchronization of the user data unit (synchronization is two way between PC and PDA, Paragraph 34).

15. Regarding Claim 10, Littleton et al. further discloses the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit (contact record) with a device data unit (anonymous call reject service feature) which is a data unit affecting the operation of the second synchronization device (Paragraph 20 and 22).

16. Regarding Claim 11, Littleton et al. further discloses the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit (contact record, Paragraph 15) with a resource identifier (phone number, Paragraph 15), which is used by at least one application (address book database application, Paragraph 20).

17. Regarding Claim 13, Littleton et al. further discloses the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit (contact record) with a device data unit (anonymous call reject service feature) which is a data unit affecting the operation of the second synchronization device (Paragraph 20 and 22).

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18. Regarding Claim 14, Littleton et al. further discloses the binding data (service feature or data fields, Paragraph 15 and 22) associates the user data unit (contact record, Paragraph 15) with a resource identifier (phone number, Paragraph 15), which is used by at least one application (address book database application, Paragraph 20).

19. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Littleton et al. (US 20030023759) in view of Hepper et al. (US 20030220966).

20. Regarding Claim 8, Littleton et al. further discloses the synchronization device is a server (Fig. 1, Item 106) and the other synchronization device is a PC (Fig. 1, Item 104) or client device PDA (Fig. 1, Item 102) and where the second synchronization device maintains a binding data table (server database, Fig. 1, Item 140) which associates the user data unit with identifier related to the device (service feature call forwarding dictates that calls received from a specific phone number will not be received and should be forwarded to another number, Paragraph 22), however Littleton et al. fails to disclose the server operating on SyncML, and the user data unit and associated device relation are associated and identified by LUIDs or GUIDs.

In an analogous art, Hepper et al. discloses a synchronization system using SyncML (Paragraph 24) and where each record is identified by a LUID and a LUID is associated to a Server ID or GUID (Paragraph 29), which enables each record to be uniquely identified.

It would have been obvious to one having ordinary skill in the art at the time of invention was made to use SyncML in order to process the synchronization data using a

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common protocol and to associate the user data unit and device to LUIDs in order to uniquely identify a record and who it belongs to.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Lim whose telephone number is (571) 270-1210. The examiner can normally be reached on Mon-Thurs 9:00am-4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER